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John Glen Cousineau

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BRANDON N. SKLAR, ESQ. (PATENT PROSECUTION)

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EXAMINER

POUNCIL, DARNELL A

ART UNIT

PAPER NUMBER

3688

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/541,620	Applicant(s) COUSINEAU ET AL.	
	Examiner DARNELL POUNCIL	Art Unit 3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 July 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/23/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Office Action is in response to the initial filing on July 07, 2005. Claims 1 - 17 are currently pending and have been considered below.

Drawings

2. The informal drawings are not of sufficient quality to permit examination. Accordingly, replacement drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to this Office action. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action.

Applicant is given a TWO MONTH time period to submit new drawings in compliance with 37 CFR 1.81. Extensions of time may be obtained under the provisions of 37 CFR 1.136(a). Failure to timely submit replacement drawing sheets will result in ABANDONMENT of the application.

EXAMINER'S NOTE

3. It appears the Applicant is attempting to invoke 35 U.S.C. 112, 6th paragraph in Claim 3-10, 14, 15, & 16 by using "means-plus-function" language, such as "means for organizing", "means for transmitting notification", "means for determining", "means for separating", means for replacing", etc. in claims below. In order to successfully invoke the sixth paragraph, a three-

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prong test must be met. Namely, (1) the claim must use means-plus-function language; (2) the claim itself must not provided structural limitations to the means-plus-function language; and (3) the specification must recite explicit physical structural limitations for the means-plus-function language in the claim. While the claims below pass the first two prongs of the three prong test, they do not pass the third prong. There is no explicit recitation in the specification of any physical structures to perform the functions of the means-plus-function limitations in the claims. The only “structure” for performing the functions in the above claims appears to be computer program or the logic to perform said programs (i.e. virtual structure, not physical structure). Therefore, 35 U.S.C 112, 6th paragraph has not been successfully invoked. The Examiner will consider the means to perform the claimed functions as any means, physical or virtual, that can perform the function.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-12 and 17 are rejected under 35 U.S.C. 101 because the claimed invention, which is interpreted to be a computer program, does not fall within at least one of the four statutory categories of invention enumerated by 35 U.S.C. 101 (MPEP § 2106.IV.B). Computer programs are nonstatutory functional descriptive material (MPEP § 2106.01.I, last para.).

Claims 13 - 16 are also rejected under 35 U.S.C. 101 because the claimed invention is not directed to statutory subject matter. Based on Supreme Court precedent, to be patent eligible under 35 U.S.C. 101 a method/process claim must (1) be tied to a particular machine or

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apparatus or (2) transform a particular article into a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 70 (1972); *Diamond v. Diehr*, 450 U.S. 192 (1981); *Parker v. Flook*, 437 U.S. 589 n.9 (1978); and *Cochrane v. Deener*, 94 U.S. 780, 788 (1876)).

Furthermore, the Supreme Court held that the use of a particular machine or transformation of an article must impose meaningful limits on the claim's scope to impart patentability (*Benson*, 409 U.S. 71-72). The involvement of the machine or transformation must not merely be insignificant extra-solution activity (*Flook*, 437 U.S. 590). Also see *In re Bilski*, No. 2007-1130, F.3d, 2008 WL4757.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1 – 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Foulger (20020032738)

In regards to **claim 1**: Foulger discloses, a distributed electronic marketing, sales and service management system, enabling the creation, distribution and tracking of at least one electronic message to at least one predetermined potential customer, said system comprising:

a) a data storage system for organizing and storing a plurality of content, selected portions of said content for insertion into the at least one electronic message; ([0046], database of resumes,(e.g. content))

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b) a production system for the creation of the at least one electronic message, said at least one electronic message having a predetermined theme, wherein content having the predetermined theme can be inserted into the at least one electronic message; [0032, 0033

c) a messaging system performing functions including transmission of the at least one electronic message to the at least one predetermined potential customer, said messaging system and the at least one predetermined customer being interconnected by at least one communication network; ([0038 & 0039], sending of email to said email target, (e.g. potential customer))

d) a tracking system for collecting and evaluating notifications based on interaction with the at least one electronic message by the at least one predetermined potential customer; [0038] wherein the data storage system, production system, messaging system and tracking system are electronically interconnected thereby enabling electronic information transfer there between. [0046, 0032, 0033, 0038, & 0039]

In regards to **claim 2**, Foulger discloses a system as in claim 1, wherein the plurality of content within the data storage system can be associated with one or more descriptors, wherein the data storage system can be searched for content having predetermined descriptors. ([0053], campaign id, version id or a contractor id.)

In regards to **claim 3**, Foulger discloses a system as in claim 1, wherein the production system provides a means for separating a previously created electronic message into component pieces, said production system further providing a means for replacing selected component

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pieces with content selected from the data storage system. [0093, 0095, 0103]

In regards to **claim 5**, Foulger discloses a system as in claim 1, further comprising a targeting system providing a means for selecting the at least one predetermined customer or group of predetermined customers, wherein said selection can be made based on a predetermined criteria wherein the at least one predetermined customer or. group of predetermined customers are associated with the predetermined criteria. ([0046, 0078] and Fig 8A)

In regards to **claim 6**, Foulger discloses a system as in claim 5, wherein said predetermined criteria provides a means for the targeting system to organize a plurality of customers into categories, wherein the at least one predetermined customer or group of predetermined customers can be assigned one of more categories based on notifications received by the tracking system. [0079, 0094 & 0102 and Fig. 8B]

In regard to **claim 7**, Foulger discloses a system as in claim 1, wherein the messaging system includes a means for modeling a generic electronic message in order to personalize the generic electronic message for a selected predetermined potential customer, said modification providing a means for the tracking system to correlate notifications with the selected predetermined potential customer. [0009]

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In regards to **claim 10**, Foulger discloses a system as in claim 1, further comprising a means for transmitting correspondence to a sales representative, said correspondence resulting from notifications received by the tracking system, said correspondence transmitted to the sales representative upon receipt of signal from the tracking system, thereby providing a means for the sales representative to timely respond to a request from the at least one predetermined customer.

[0108]

In regards to **claim 11**, Foulger discloses a system as in claim 10, wherein the correspondence is a SMS or cellular telephone call. [0108]

In regards to **claims 13 & 17**, Foulger discloses or the creation, distribution and tracking of at least one electronic message to at least one predetermined potential customer, said method comprising the steps of:

- a) organizing and storing plurality of content, selected portions of said content for insertion into the at least one electronic message; [0046],
- b) creating the at least one electronic message, said at least one electronic message having a predetermined theme, wherein content having the predetermined theme can be inserted into the at least one electronic message; [0032, 0033]
- c) transmitting the at least one electronic message to the at least one predetermined potential customer; [0038 & 0039],
- d) collecting and evaluating notifications based on interaction with the at

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least one electronic message by the at least one predetermined potential customer; [0046, 0032, 0033, 0038, & 0039]

In regards to the following claim language, is considered to be intended use and thus no patentable weight has been given: “wherein the collection and evaluation of the notifications enables incorporation of content relating to these previous notifications into a subsequently created and transmitted electronic message to the same predetermined potential customer.”

In regards to **claim 14**, Foulger discloses a method as in claim 13, wherein prior to the step of organizing and storing the plurality of content, each piece of content of the plurality of content can have at least one descriptor associated therewith thereby providing a means for organizing the plurality of content. [0053]

In regards to claim 15, Foulger discloses a method as in claim 13, wherein the step of creating the at least one electronic message includes inserting at least one interaction point into the at least one electronic message, said interaction point including a means for transmitting notifications to a tracking system. [0011]

In regards to claim 16, Foulger discloses a method as in claim 13, wherein the step of collecting and evaluating notifications provides a means for determining a theme for an electronic message subsequently transmitted to the same at least one potential customer. [0078 – 0079]

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8. **Claim 4** is rejected under 35 U.S.C. 103(a) as being unpatentable over Foulger (20020032738) in view of Janakiraman et al. (US 20030023598)

In regards to claim 4, Foulger discloses a system as in claim 1, but does not explicitly disclose wherein the production system provides a means for separating a multimedia content item into component pieces and creating a "semantic outline thereof, said production system further providing a means for presenting the semantic outline alongside the multimedia content item, said production system providing a means for modification of the multimedia content item through replacement of component peices with alternate content selected from the data storage system producing amended multimedia content item, said production system thereby enabling viewing of the amended multimedia content item simultaneously with the semantic outline for ease of amendment.

However Janakiraman discloses wherein the production system provides a means for separating a multimedia content item into component pieces and creating a "semantic outline thereof, said production system further providing a means for presenting the semantic outline alongside the multimedia content item, said production system providing a means for modification of the multimedia content item through replacement of component peices with alternate content selected from the data storage system producing amended multimedia content item, said production system thereby enabling viewing of the amended multimedia content item simultaneously with the semantic outline for ease of amendment. [0048 & 0049]

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention, to have modified system of Foulger as to include provides a means for separating a multimedia content item into component pieces and creating a "semantic outline thereof, said production system further providing a means for presenting the semantic outline alongside the multimedia content item, said production system providing a means for modification of the multimedia content item through replacement of component pieces with alternate content elected from the data storage system producing amended multimedia content item, said production system thereby enabling viewing of the amended multimedia content item simultaneously with the semantic outline for ease of amendment., in order to provide a system of editing said multimedia content, enabling the ability to manipulate multimedia, by labeling, thereby allowing the media to be organized, edited for suitable use and to be stored for later use, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

9. Claims 8, 19, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foulger (20020032738) in view of Official Notice.

In regards to **claim 8**, Foulger discloses a system as in claim 7, but does not explicitly disclose wherein the messaging system includes a means for electronically transmitting the at least one electronic message to an intermediate host, said intermediate host subsequently transmitting the at least one electronic message to the at least one predetermined customer, and said intermediate host; being identified to the at least one predetermined customer as originator

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of the transmission of the at least one electronic message. However transmitting an electronic message to an intermediate host and said intermediate host transmitting to a predetermined recipient is well known to those of ordinary skill in the art, and Official Notice to that effect is hereby taken. For example when sending an electronic message over the Internet, the message will be received and forwarded through several router servers (e.g. intermediate hosts) before reaching it's destination.

It would have been obvious to one of ordinary skill in the art, at the time of the invention to have modified the system of Foulger so as to have included a means for electronically transmitting the at least one electronic message to an intermediate host, said intermediate host subsequently transmitting the at least one electronic message to the at least one predetermined customer, and said intermediate host; being identified to the at least one predetermined customer as originator of the transmission of the at least one electronic message, in order to provide the ability to send electronic messages internationally, since doing so could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

In regards to **claim 9**, Foulger discloses a system as in claim 1, but does not explicitly disclose a monitoring system for evaluating the functionality of the distributed electronic management system, said monitoring system providing a means for transmission of an alarm to a system manager upon detection of a potential problem. However evaluating an electronic system and sounding an alarm upon detection of a problem is well known to those of ordinary skill in

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the art, and Official Notice to that effect is hereby taken. For example the security application monitoring a personal computer sounds an alarm if a virus is detected in the personal computer.

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Foulger so as to have evaluating the functionality of the distributed electronic management system, said monitoring system providing a means for transmission of an alarm to a system manager upon detection of a potential problem in order to provide users with an application to monitor the system to insure the system is running efficiently, since doing so could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

In regards to **claim 12**, Foulger discloses a system as in claim 1, comprising a firewall [0065] but does not explicitly disclose further comprising a data replication system enabling data transfers from a first database to a second database, wherein the first and second databases are each protected by a firewall type system. However copying information between multiple databases protected by a firewall is well known to those of ordinary skill in the art, and Official Notice to that effect is hereby taken. For example, it is common for nationwide companies to backup local files onto a separate national server , each protected with its own firewall., for security purposes.

It would have been obvious to one of ordinary skill in the art, at the time of the invention to have modified the system of Foulger so as to have included a data replication system enabling data transfers from a first database to a second database, wherein the first and second databases are each protected by a firewall type system, in order to have a backup information of the first

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copied to the second database and to have a firewall to insure security while copying information.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DARNELL POUNCIL whose telephone number is (571)270-3509. The examiner can normally be reached on Monday to Thursday 8 to 5 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Myhre can be reached on (571)272-6722. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. P./
Examiner, Art Unit 3688

/James W Myhre/
Supervisory Patent Examiner
Art Unit 3688